



Serial No. 10/618,113
Attorney Docket No. 11948.0021

IFW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application:
Rajeev Joshi et al.

Serial No.: 10/618,113

Filed: July 11, 2003

For: WAFER-LEVEL CHIP SCALE PACKAGE AND
METHOD FOR FABRICATING AND USING THE
SAME

Confirmation No. 8697

Group Art Unit: 2826

Examiner: Williams, Alexander O.

Mail Stop Non-Final Response
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

In response to the Office Action mailed June 9, 2003, Applicant requests reconsideration of the restriction requirement in light of the following remarks.

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Commissioner for Patents, Alexandria, VA 22313-1450, on this 28th day of June 2004.

Signed: _____

John Bawden

6/28/2004

The Restriction Requirement

The Office has required restriction to one of the following groups of inventions under 35 U.S.C. § 121:

Group I: claims 1-19, drawn to a wafer level chip scale package, classified in class 257, subclass 700; and

Group II: claims 20-33, drawn to a method of making a wafer level chip scale package, classified in class 438, subclass 15+.

The Office argues that Groups I and II are related as a process of making and product made. The Office alleges that the inventions of these two groups are distinct since the product as claimed can be made by another and materially different process such as instead of forming the insulating layer without using a high temperature curing process, it can be formed by using a high temperature curing process.

Applicant elects with traverse to prosecute the invention of Group II, claims 20-33. Applicant's traversal is on the grounds that the office has not substantiated that restriction between the claims of Group I and Group II is warranted.

To begin with, the Office has not even shown—or less alleged—that the claims for Groups I and Group II are independent. 35 U.S.C. § 121 requires that for restriction to be proper, the Office must show that groups of claims are both independent and distinct. *See also M.P.E.P. §§ 802; 802.01.* The Office, however, has only alleged that the claims are distinct for these reasons given above.

The Office can still require restriction where only distinctness has been argued, provided that the Office shows that there is a serious burden on the Examiner. *See M.P.E.P. § 803*. But the Office has not argued that there exists a serious burden, i.e., by substantiating that the groups of claims have acquired a separate status in the art as shown by their different classification.

Applicant also disagrees that the Office has shown that the invention of Group I can be made the proposed other and “materially different” process. The proposed materially different process is one that uses a high temperature curing process. But this is not a “materially different” process than the process recited in the claims. The pending independent method claims recite a process that forms an insulating layer of a non-polymeric dielectric material. There is no mention in the independent claims of either using—or not using—a high temperature curing process.¹ Thus, the process proposed by the Office is not “materially different” from the claims process and the Office, therefore, has not substantiated that groups of claims are distinct.

Accordingly, the Office has not established a proper restriction requirement between Groups I and II and Applicant requests withdrawal of this restriction requirement and examination of all pending claims.


CONCLUSION

For the above reasons, Applicant respectfully requests the Office to withdraw the restriction requirement and examine all the pending claims.

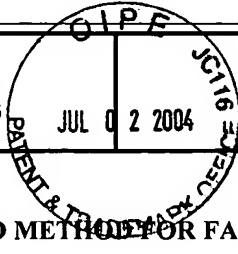


¹ Such a recitation only occurs in dependent claim 27.

If there is any fee due in connection with the filing of this Request, including a fee for any extension of time not accounted for above, please charge the fee to our Deposit Account No. 50-0843.

Respectfully Submitted,

By 
KENNETH E. HORTON
Reg. No. 39,481

Date: June 28, 2004

AMENDMENT TRANSMITTAL LETTER (Large Entity)				Docket No. 11948-0021	
Applicant(s): R. Joshi, et al.					
Serial No. 10/618,113	Filing Date July 11, 2003		Examiner A. O. Williams	Group Art Unit 2826	
Invention: WAFER-LEVEL CHIP SCALE PACKAGE AND METHOD FOR FABRICATING AND USING THE SAME					
<u>TO THE ASSISTANT COMMISSIONER FOR PATENTS:</u>					
Transmitted herewith is an amendment in the above-identified application.					
The fee has been calculated and is transmitted as shown below.					
CLAIMS AS AMENDED					
	CLAIMS REMAINING AFTER AMENDMENT	HIGHEST # PREV. PAID FOR	NUMBER EXTRA CLAIMS PRESENT	RATE	ADDITIONAL FEE
TOTAL CLAIMS	14 -	33 =	0 x	\$18.00	\$0.00
INDEP. CLAIMS	4 -	8 =	0 x	\$80.00	\$0.00
Multiple Dependent Claims (check if applicable) <input type="checkbox"/>					\$0.00
TOTAL ADDITIONAL FEE FOR THIS AMENDMENT					\$0.00
<input checked="" type="checkbox"/> No additional fee is required for amendment. <input type="checkbox"/> Please charge Deposit Account No. _____ in the amount of _____ A duplicate copy of this sheet is enclosed. <input type="checkbox"/> A check in the amount of _____ to cover the filing fee is enclosed. <input checked="" type="checkbox"/> The Commissioner is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 50-0843 A duplicate copy of this sheet is enclosed. <input checked="" type="checkbox"/> Any additional filing fees required under 37 C.F.R. 1.16. <input type="checkbox"/> Any patent application processing fees under 37 CFR 1.17.					
 _____ Signature			Dated: 6/28/04		
Kenneth E. Horton, Reg. 39,481 Kirton & McConkie P.O. Box 45120 Salt Lake City, UT 84145-0120			I certify that this document and fee is being deposited on June 29 , 2004 with the U.S. Postal Service as first class mail under 37 C.F.R. 1.8 and is addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231.  _____ Signature of Person Mailing Correspondence JoAnn Bawden _____ Typed or Printed Name of Person Mailing Correspondence		
CC:					